

REMARKS

The Office action dated September 9, 2003 and the cited references have been carefully considered.

Status of the Claims

Claims 1-45 are pending.

Claims 1-45 are rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-3, 6, 37, and 43 are rejected under 35 U.S.C. § 102(a) as being anticipated by the abstract of Eustace et al. (Chem. Innovation, Vol. 31, Issue 4, pp. 31-38 (2001); hereinafter "Eustace"). The Applicants respectfully traverse all of these rejections for the reasons set forth below.

Claim Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1-45 are rejected under 35 U.S.C. § 112, second paragraph. Specifically, the abbreviation "CHTS" in claims 1 and 37 is allegedly "vague and indefinite due to lacking citation therewith of a full name for clarity." Claims 1 and 37 are amended to recite "combinatorial high throughput screening" as the full reference for CHTS (please see paragraph 2 of the specification). No new matter is added. Therefore claims 1-45 now overcome this rejection. Early allowance of the claims is respectfully requested.

Claim Rejection Under 35 U.S.C. § 102(a)

Claims 1-3, 6, 37, and 43 are rejected under 35 U.S.C. § 102(a) as being anticipated by Eustace. The Applicants respectfully traverse this rejection because Eustace does not disclose each and every element of each of claims 1-3, 6, 37, and 43.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single* prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis

added). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

The abstract of Eustace mentions very cryptically that "Six Sigma tools . . . were employed in the development of testing methods and enabled quality measurements to match product control requirements." Such vague and non-specific mention does not qualify as anticipatory prior art against more specific claims.

Eustace does not disclose specifically a combinatorial high throughput screening ("CHTS") experiment program wherein a Six Sigma technique is applied to at least a common step of each of the experiments of the CHTS experiment program, as is recited in claims 1-3, 6, 37, and 43. Nor can it be inferred from Eustace that a Six Sigma technique is applied to a CHTS experimental program, as is recited in claims 1-3, 6, 37, and 43. Thus, Eustace does not disclose each and every elements of each of claims 1-3, 6, 37, and 43.

Since Eustace does not disclose explicitly or inherently each and every element of each of claims 1-3, 6, 37, and 43, Eustace does not anticipate these claims.

In view of the above, it is submitted that the claims are patentable and in condition for allowance. Reconsideration of the rejection is requested. Allowance of claims at an early date is solicited.

Respectfully submitted,



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